



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/082,328	06/24/93	KNIGHT	T 7828003

21M1/0825  
FENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

EXAMINER

SPARKS, D

ART UNIT

PAPER NUMBER

2103

22

DATE MAILED: 08/25/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/082,328**

Applicant(s)  
**Knight et al.**

Examiner  
**Donald A. Sparks**

Group Art Unit  
**2103**



☒ Responsive to communication(s) filed on May 23, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-28, 30-79, 102-200, and 203-209 is/are pending in the application.

Of the above, claim(s) 2-27, 30-36, 49-51, 60-79, 103-142, 145, 148-200 <sup>203-209</sup> is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 28, 37-43, 45-48, 52-58, 102, 143, 144, 146, and 147 is/are rejected.

☒ Claim(s) 44 and 59 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

The examiner acknowledges the applicant's submission of the amendment dated September 9, 1996. Thus, claims 1-28, 30-79, 102-200 and 203-209 are pending in the instant application. Claims 29, 80-101, 201 and 202 have been canceled.

#### **1. INFORMATION CONCERNING DRAWINGS**

##### **Drawings**

As required by M.P.E.P. § 707.07 and M.P.E.P. § 707.07(e), the examiner reminds the applicant's of the necessary drawing corrections required by the draftsman indicated on the PTOL-948 which accompanied the office action dated March 7, 1996.

#### **2. RESPONSE TO THE APPLICANT'S ELECTION**

Applicant's election with traverse of Species VII involving figures 10-12B in Paper No. 21 dated May 23, 1997 is acknowledged. The applicant states that claims 37-48, 52-59, 143, 144, 146 and 147 read on the elected species. The applicant follows up by stating that the numerous species identified by the examiner is unwarranted. The applicant offers the position that many of the structures illustrated in the figures are not distinct from that of figure 1, rather they are simply more complicated structures extending from the same principles set forth in the embodiment of Figure 1 or they explain advantages of the present invention. The examiner

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disagrees with the applicant's position and the following response is offered in support of the examiner's position.

**1<sup>st</sup> POINT OF ARGUMENT:**

The examiner has reviewed the applicant's election dated May 23, 1997 and emphasizes that the examiner clearly indicated in the species election dated December 24, 1996 that *should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case* applicant has failed to meet the policy required by the Office. Furthermore, the Examiner emphasizes that Species I-VI and VIII-XIX include **mutually exclusive elements** that are considered to be patentably distinct from the structure embodied in Species VII. Based on the above criteria, the request for an election of a single species for examination by the examiner is proper.

The requirement is still deemed proper and is therefore made **FINAL**.

Thus, claims 2-28, 30-36, 49-51, 60-79, 103-142, 145, 148-200 and 203-209 have been withdrawn from further consideration by the examiner and claims 1, 28, 37-48, 52-59, 102, 143, 144, 146 and 147 are ready for examination by the examination in the application.

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**3. REJECTIONS NOT BASED ON PRIOR ART**

**a. DEFICIENCIES IN THE SPECIFICATION**

**Specification**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. “**METHOD AND**” must be deleted.

The disclosure is objected to because of the following informalities:

This application **does not** contain an abstract of the disclosure as required by 37

CFR 1.72(b)..

Appropriate correction is required.

**:IMPORTANT NOTE:**

**An abstract on a separate sheet is required.**

**4. REJECTIONS BASED ON PRIOR ART**

**a. REJECTIONS BASED ON LACK OF NOVELTY**

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

-- Claims 1,28,37-39,41,42,43,47,52-57,102,143,144,146 and 147 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 5,404,265 awarded to Moresco et al.

See figures 1A-1D

**:IMPORTANT NOTE:**

The 5,404,265 reference is a U.S. patent awarded to Moresco et al. that claims the rejected invention. An affidavit or declaration is inappropriate under **37 CFR 1.131(a)** when the patent is claiming the same patentable invention, see **MPEP § 2306**. The patent can only be overcome by establishing priority of invention through interference proceedings. See **MPEP Chapter 2300** for information on initiating interference proceedings.

**b. REJECTIONS BASED ON LACK OF NONOBVIOUSNESS**

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

-- Claims 40,45,46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,404,265 awarded to Moresco et al.

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Claims 40,45,46 and 48 define over the structure of Moresco et al. (5,404,265) by the requirement that **portions of the chip are passivated and securely fastened together**. It is an expedient in the art to provide a **passivation layer on the bottom surface of the chip adjacent to elements 30** for the purpose of **limiting the flow of solder and preventing the contacts from shorting together during the bonding process**. Furthermore, to use an adhesive material for the dielectric would also have been within the skill of a practitioner in the art in an effort to prevent the half capacitor from separating from one another.

**5. ACKNOWLEDGMENT OF ISSUES RAISED BY THE APPLICANT**

**Response to Amendment**

Applicant's arguments filed September 9, 1996 have been fully considered but they are not deemed to be persuasive and, as required by M.P.E.P. § 707.07(f), a response to these arguments appears below.

**a. ARGUMENTS CONCERNING FORMAL MATTERS**

The formal requirements requested by the examiner are addressed in the following section as required by M.P.E.P. § 707.07(f).

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**6. ARGUMENTS CONCERNING PRIOR ART REJECTIONS**

**1<sup>st</sup> POINT OF ARGUMENT:**

Applicant's arguments with respect to claims 1,28,37-48,52-59,102,143,144,146 and 147 have been considered but are moot in view of the new ground(s) of rejection.

**7. CLOSING COMMENTS**

**Conclusion**

**a. STATUS OF CLAIMS IN THE APPLICATION**

The following is a summary of the treatment and status of all claims in the application as recommended by M.P.E.P. § 707.07(i):

**a(1) SUBJECT MATTER CONSIDERED ALLOWABLE**

Claims 44 and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**a(2) CLAIMS NO LONGER IN THE APPLICATION**

Claims 29,80-101,201 and 202 have been canceled.



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**a(3) CLAIMS NO LONGER UNDER CONSIDERATION BY EXAMINER**

Claims 2-28,30-36,49-51,60-79,103-142,145 and 148-200 and 203-209 were withdrawn from consideration as a result of the applicant's election dated May 23,1997.

**a(4) CLAIMS REJECTED IN THE APPLICATION**

Per the instant office action, claims 1,28,37-48,52-59,102,143,144,146 and 147 have received a second action on the merits and are subject of a second action non-final.

For at least the above reasons it is the examiner's position that the applicant's claims are not in condition for allowance.

**b. DIRECTION OF ALL FUTURE REMARKS**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald A. Sparks whose normally available during the working hours of **6:30 A.M. to 3:00 P.M. Mon. thru Fri.** and can be reached at telephone number (703) 308-1756.

**:IMPORTANT NOTE:**

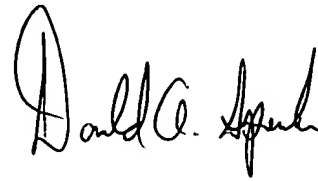
If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Leo P. Picard, can be reached at the following telephone number: Area Code(703) 308-0538.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1782.

A handwritten signature in black ink, appearing to read "Donald A. Sparks". The signature is stylized with a large initial "D" and a cursive "A".

**Donald A. Sparks**  
**Primary Examiner**  
**Art Unit 2103**

August 20, 1997